

REMARKS

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for the acknowledgment of Applicant's Claim for Priority and receipt of the certified copy of the priority document in the Official Action.

Upon entry of the above amendments claims 1 and 9 will have been amended. Claims 1-16 are currently pending. Applicant respectfully requests entry of the present amendments, reconsideration of the outstanding rejections, and allowance of all the claims pending in the present application.

On pages 2 and 3 of the Official Action, claims 1 and 9 were rejected under 35 U.S.C. § 102(b) as being anticipated by VELZEL et al. (U.S. Patent No. 4,850,673).

Applicant respectfully traverses the rejection of claims 1 and 9 under 35 U.S.C. § 102(b).

Claims 1 and 9 each recite, inter alia, "wherein said deflector includes a single-element prism having a first surface into which the light beam from said light emitting device enters, a second surface from which the light beam proceeding toward said objective lens emerges, and a third surface from which the light beam reflected from the optical disc emerges, the light beam emerged from the third surface proceeding toward said error signal detecting system, wherein the light beam from said light emitting device is deflected by the first surface, and the light beam reflected by the optical disc is reflected by the first surface".

Applicant submits that VELZEL et al. lacks any disclosure of a *single-element prism* including the first, second and third surfaces as recited in the claims, much less *a light beam from a light emitting device being deflected by the first surface, and a light beam reflected by an optical disc being reflected by the first surface.*

In this regard, Applicant submit that that beam splitter 8 of VELZEL et al. does not constitute such a *single-element prism*, and that the surface 8A (as designated by the Examiner in the marked-up Fig. 1 included in the Official Action) does not constitute such a *first surface* (i.e., which *deflects a light beam from a light emitting device and reflects a light beam reflected by an optical disc*).

Applicant respectfully submits that the rejection of claims 1 and 9 under 35 U.S.C. § 102(b) is improper at least for each and certainly for all of the above-noted reasons. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection, and an early indication of the allowance of all of the pending claims.

On pages 4 and 5 of the Official Action, claims 1, 7-9, 15 and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by ANDO (U.S. Patent Application Publication No. 2001/0048553).

Applicant respectfully traverses the rejection of claims 1, 7-9, 15 and 16 under 35 U.S.C. § 102(b).

Claims 1 and 9 each recite, inter alia, “wherein said deflector includes a single-element prism having a first surface into which the light beam from said light emitting device enters, a second surface from which the light beam proceeding toward said objective lens emerges, and a third surface from which the light beam reflected from the optical disc emerges, the light beam emerged from the third surface proceeding toward said error signal detecting system, wherein the light beam from said light emitting device is deflected by the first surface, and the light beam reflected by the optical disc is reflected by the first surface”.

Applicant submits that ANDO lacks any disclosure of a *single-element prism* including the first, second and third surfaces as recited in the claims, much less *a light beam from a light*

emitting device being deflected by the first surface, and a light beam reflected by an optical disc being reflected by the first surface.

In this regard, Applicant submit that that beam splitter 130 (Fig. 6) of ANDO does not constitute such a *single-element prism*, and that the surface 133b does not constitute such a *first surface* (i.e., which *deflects a light beam from a light emitting device and reflects a light beam reflected by an optical disc.*

Applicant also submits that dependent claims 7, 8, 15 and 16, which are at least patentable due to their dependency from claims 1 and 9 for the reasons noted above, recite additional features of the invention and are also separately patentable over the prior art of record. For example, Applicant submits that ANDO lacks any disclosure of a *first surface as recited in the independent claims* which is formed as a *beam splitting surface* (claims 7 and 15) or which is formed as a *half mirror surface* (claims 8 and 16).

Applicant respectfully submits that the rejection of claims 1, 7-9, 15 and 16 under 35 U.S.C. § 102(b) is improper at least for each and certainly for all of the above-noted reasons. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection, and an early indication of the allowance of all of the pending claims.

On pages 5 and 6 of the Official Action, claims 2-6 and 10-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over VELZEL et al. (U.S. Patent No. 4,850,673) in view of KUBO (U.S. Patent No. 5,684,762).

Applicant respectfully traverses the rejection of claims 2-6 and 10-14 under 35 U.S.C. §103(a).

Applicant initially submits that the teachings of KUBO do not cure the above-noted deficiencies in the disclosure of VELZEL et al. with regard to claims 1 and 9. Further, Applicant

submits that claims 2-6 and 10-14, which are at least patentable due to their dependency from claims 1 and 9 for the reasons noted above, recite additional features of the invention and are also separately patentable over the prior art of record.

Applicant also submits that the modifications suggested by the Examiner would not have been obvious to one having ordinary skill in the art in view of the teachings of VELZEL et al. and KUBO. In this regard, Applicant submits that the teachings of KUBO do not cure the deficiencies in the disclosure of VELZEL et al. with regard to the subject matter of these dependent claims. Applicant further submits that the modifications suggested by the Examiner are clearly the result of impermissible hindsight reasoning based upon the disclosure of the present application, rather than the teachings of the references themselves.

Applicant respectfully submits that the rejection of claims 2-6 and 10-14 under 35 U.S.C. § 103(a) is improper at least for each and certainly for all of the above-noted reasons. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and an early indication of the allowance of these claims.

On pages 6-8 of the Official Action, claims 1, 7-9, 15 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over KOBAYASHI et al. (U.S. Patent No. 5,581,403).

Applicant respectfully traverses the rejection of claims 1, 7-9, 15 and 16 under 35 U.S.C. §103(a).

Claim 1 recites, inter alia, “said prism satisfies a condition: $\theta_1 = -\theta_2$ where θ_1 represents an angle which the second surface forms with respect to the first surface, and θ_2 represents an angle which the third surface forms with respect to the first surface, polarity of each of the angles θ_1 and θ_2 being defined depending on whether the each of the angles θ_1 and θ_2 has counterclockwise direction or has clockwise direction.”

Claim 9 recites, inter alia, “said prism satisfies a condition: $-\pi/1080 \text{ radian} \leq \alpha_1 + \beta_1 \leq \pi/1080 \text{ radian}$ where α_1 represents an emergence angle which the light beam emerging from the second surface and proceeding toward said objective lens forms with respect to a normal to the second surface, β_1 represents an emergence angle which the light beam emerging from the third surface and proceeding toward said error signal detecting system forms with respect to a normal to the third surface, polarity of each of the angles α_1 and β_1 being defined depending on whether the each of the angles α_1 and β_1 has counterclockwise direction or has clockwise direction.”

In the Official Action, the Examiner acknowledges that KOBAYASHI et al. lacks any disclosure of these features recited in claims 1 and 9, but takes the position that these features would have resulted from routine experimentation by one of ordinary skill in the art (apparently as optimum or workable ranges).

Applicant submits that these features recited in claims 1 and 9 would not have been obvious to one having ordinary skill in the art, and would not result from routine experimentation. In this regard, the Examiner is asked to review pages 1-5 of the present application which discusses the problems of prior art systems, and the discussion of the present invention on pages 6-10 and 14-18 of the present application, which discusses the benefits of these features recited in claims 1 and 9. Applicant submits that the invention as recited in claims 1 and 9 would require more than mere routine experimentation, and represents more than merely optimum or workable ranges, or a mere matter of design. Applicant notes that the Examiner’s stated position would appear to imply, by extension, that all lens, prism or optical system designs would result from routine experimentation, and thus be unpatentable, which is clearly untenable. Applicant respectfully requests that the Examiner provide evidence to support his contention if he insists on maintaining this position.

Applicant also submits that dependent claims 7, 8, 15 and 16, which are at least patentable due to their dependency from claims 1 and 9 for the reasons noted above, recite additional features of the invention and are also separately patentable over the prior art of record.

Applicant respectfully submits that the rejection of claims 1, 7-9, 15 and 16 under 35 U.S.C. § 103(a) is improper at least for each and certainly for all of the above-noted reasons. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and an early indication of the allowance of these claims.

SUMMARY

Applicant respectfully requests entry of the present amendments, reconsideration of the outstanding rejections, and allowance of all the claims pending in the present application. Applicant has argued the allowability of the claims and pointed out deficiencies of the applied references. Accordingly, reconsideration of the outstanding Official Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered cosmetic in nature, and to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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June 6, 2007
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